

REMARKS

In an office action dated 7 January 2005, the Examiner rejects claims 1-26 (all pending claims). In response to the office action, Applicants cancel claims 24-26 and respectfully traverse the rejections. Claims 1-23 remain in the application. In light of the amendments and the following arguments, Applicants respectfully request that this Application be allowed.

The Examiner rejects claims 1 and 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,068,619 issued to Nakano et al. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The **test for anticipation** is symmetrical to the test for infringement and has been stated as: “That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). The Examiner has not provided a single reference that teaches all of the elements as arranged in claims 1 and 12.

Claim 1 recites a non-conductive spacer forming a first wall having an exterior and an interior, said non-conductive spacer coupled to said interior of said outer conductor; a conductive

layer forming a second wall having an exterior and an interior, said conductive layer coupled to said interior of said first wall; and an insulating layer forming a third wall having an exterior and an interior, said insulating layer coupled to said interior of said second wall. Nakano does not teach this limitation. Instead, Nakano teaches a probe having an outer transmitting electrode and an inner receiving electrode. See Column 3, lines 7-12. These electrodes may have an intermediate electrode may be disposed between the receiving and transmitting electrodes. See Col. 3, lines 13-17. Furthermore, there may be a guard ring around the outer circumference for preventing induction. See, Column 3, lines 10-12. However, nowhere in Nakano is there a description of a non-conductive layer between the outer/transmitting electrode and intermediate electrode and an insulating layer between the inner/receiving electrode. Figures 2 and 3 do show space between the various components of the Nakano probe. However, there is no description that this is non conductive or insulating material. In fact, although not perfect this may just be spacing between components. Claim 1 on the other hand recites the non-conductive and insulating layers which help reduce capacitance between electrodes and allow the probe to provide better readings. The Examiner is reminded that if the Examiner is stating that it is inherent that the space shown between the electrodes in the Nakano probe is non-conductive the an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). For these reasons, Applicants respectfully request the rejection of claim 1 be removed and claim 1 be allowed.

Claims 2-11 depend from claim 1. Thus, claims 2-11 are allowable for at least the same reasons as claim 1. Therefore, Applicants respectfully request that the rejections of claims 2-11 be removed and claims 2-11 be allowed.

Claim 12 recites a probe system that includes the same probe as recited in claim 1. Thus, claim 12 is allowable for at least the same reasons as stated for claim 1. Thus, Applicants respectfully request that the rejection of claim 12 be removed and claim 12 be allowed.

Claims 13-23 depend from claim 12. Thus, claims 13-23 are allowable for at least the same reasons as claim 12. Therefore, Applicants respectfully request that the rejections of claims 13-23 be removed and claims 13-23 be allowed.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
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